

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-10, 12-23, 25 and 27-36 were pending prior to the Office Action. In this reply, claims 37-44 are added. Therefore, claims 1-10, 12-23, 25 and 27-44 are pending. Claims 1, 5, 6, 8 and 30 are independent.

ALLOWABLE CLAIM

Applicant thanks the Examiner for indicating that claim 6 is allowable.

§ 112, 1ST PARAGRAPH REJECTION

Claims 1-5, 7-10, 12-23, 25, 27-29 and 34-35 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. More specifically, the Examiner alleges that the feature of indicating the external device communication function as priority over indicating the moving-image caption function is not supported in the original specification of the application.

Applicant respectfully disagrees. Nevertheless, some claims are amended to promote the progress of prosecution of the application. As amended, independent claim 1 recites, in part “wherein the indicating device indicates the external device communication function when a communication with an

external device is performed” and “wherein the indicating device indicates the moving-image capturing function when the communication with the external device is not performed and the moving-image capturing is performed.” These features are clearly supported. *See Figure 9 (step S18) and Figure 10.*

Amended independent claim 5 recites, in part, “wherein the first indicating device indicates the two-way communication with the external device when the two-way communication is performed” and “wherein the first indicating device indicates the self-timer image-capturing function when the two-way communication is not performed and the self-timer image-capturing is performed.” These features are also clearly supported. *See Figure 9 (step S30) and Figure 11.*

Amended independent claim 8 recites, in part “wherein the step of indicating the communications processing is performed when the camera is performing the communications processing with an external device” and “wherein the step of indicating the self-timer image capturing function is performed when the camera is not performing the communications processing with the external device and is performing the self-timer image capturing function.” These features are also clearly supported. *See Figure 9 (step S30) and Figure 11.*

Dependent claim 34 recites, in part “wherein the indicating device is configured to indicate that the self-timer image-capturing is taking place when

the camera does not perform the external device communication and the camera performs the self-timer image-capturing.” This feature is clearly supported. *See Figure 9 (step S30) and Figure 11.*

Dependent claim 35 recited, in part “wherein the indicating device is configured to indicate that the moving image-capturing is taking place when the camera does not perform the external device communication and the camera performs the moving image-capturing.” This feature clearly supported. *See Figure 9 (step S18) and Figure 10.*

For at least the above stated reasons, Applicant respectfully requests that the § 112, First Paragraph rejection of claims 1-5, 7-10, 12-23, 25, 27-29 and 34-35 be withdrawn.

§ 103 REJECTION – OKINO, AOI

Claims 1-4, 8-10, 15-20, 27-28, 30-31 and 33-36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okino et al. (U.S. Patent 5,214,516) in view of Aoi et al. (U.S. Publication 2003/0169349). Applicant respectfully traverses.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142.* One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142;*

M.P.E.P. 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

For example, independent claim 1 recites, in part “wherein the indicating device indicates the external device communication function when a communication with an external device is performed” and “wherein the indicating device indicates the moving-image capturing function when the communication with the external device is not performed and the moving-image capturing is performed.” The combination of Okino and Aoi cannot teach or suggest these features.

First, there is no teaching or suggestion whatsoever that the digital camera as disclosed in Okino has a capability to communicate with an external device. Because there is no external device communication capability, it logically follows that Okino cannot teach or suggest the feature of “wherein the indicating device indicates the external device communication function when a communication with an external device is performed” and the feature of “wherein the indicating device indicates the moving-image capturing function when the communication with the external device is not performed and the moving-image capturing is performed.” Aoi is not relied upon to correct for this deficiency of Okino. Thus, the combination of Okino and Aoi cannot teach or suggest the above recited feature. This is sufficient to distinguish independent claim 1 from Okino and Aoi.

Second, Okino does not disclose indicating moving image-capturing. In previous replies, Applicant demonstrated that the LED 5 is flashed to indicate that the digital camera is in a voice recording mode. The Examiner alleged that since image capturing and voice recording occurs simultaneously, indication of voice recording is equivalent to indication of moving image-capturing mode. This is not so.

Okino teaches that the release switch 1 is operated to capture images and voice recording mode switch 2 is operated to put the camera in the voice recording mode. However, it is not necessary that the voice recording mode switch be operated to capture images. In other words, images may be captured without activating the voice recording mode, and thus, there would be no indication of image capturing displayed on the LED 5. Accordingly, contrary to the Examiner's allegation, Okino cannot teach or suggest the feature of indicating the moving image-capturing function. Aoi is not relied upon to correct for this deficiency.

Further, the Examiner alleges that in Okino, the LED is flashed at varying intervals to provide different types of indication to indicate different stages of audio recording. Even if this allegation is taken to be true, this cannot teach or suggest the feature of "wherein the indicating device indicates the moving-image capturing function when the communication with the external device is not performed and the moving-image capturing is

performed.” Indeed, both Okino and Aoi are silent regarding indicating that the external communication is taking place and indicating that another function – such as moving image-capturing – is taking place when the external communication is not taking place.

For at least the above stated reasons, independent claim 1 is distinguishable over Okino and Aoi.

Independent claim 8 recites, in part “wherein the step of indicating the communications processing is performed when the camera is performing the communications processing with an external device” and “wherein the step of indicating the self-timer image capturing function is performed when the camera is not performing the communications processing with the external device and is performing the self-timer image capturing function.” It is demonstrated above that the combination of Okino and Aoi cannot teach or suggest these features. Accordingly, independent claim 8 is distinguishable over Okino and Aoi.

Independent claim 30 recites, in part “wherein the indicating device is configured to ... indicate the moving image-capturing is taking place when the camera performs the moving image-capturing.” It is demonstrated above that the combination of Okino and Aoi cannot teach or suggest this feature. Accordingly, independent claim 30 is distinguishable over Okino and Aoi.

Claims 2-4, 9-10, 15-20, 27-28, 31 and 33-36 depend from independent claims 1, 8 or 30, directly or indirectly. Accordingly, these dependent claims are also distinguishable over the combination of Okino and Aoi for at least due to their dependencies from independent claims 1, 8, and 30.

Applicant respectfully requests at the rejection of claims 1-4, 8-10, 15-20, 27-28, 30-31 and 33-36 based on Okino and Aoi be withdrawn.

§ 103 REJECTION – OKINO, AOI, OHMURA

Claims 5, 7, 12-14, 21-23 and 25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okino in view of Aoi, and in further view of Ohmura et al. (U.S. Publication 2003/0011702). Applicant respectfully traverses.

Independent claim 5 recites, in part “wherein the first indicating device indicates the two-way communication with the external device when the two-way communication is performed” and “wherein the first indicating device indicates the self-timer image-capturing function when the two-way communication is not performed and the self-timer image-capturing is performed.” It is demonstrated above that the combination of Okino and Aoi cannot teach or suggest these features. Ohmura is not relied upon to correct for at least this deficiency of Okino and Aoi. Therefore, claim 5 is also distinguishable over the combination of Okino, Aoi and Ohmura.

Claims 7 and 22-23 depend from independent claim 5. Accordingly, these claims are also distinguishable over the combination of Okino, Aoi, and Ohmura for at least due to their dependencies from claim 5.

Claims 12-14, 21 and 25 depend from independent claims 1 or 8, directly or indirectly, and it is demonstrated above that claims 1 and 8 are distinguishable over Okino and Aoi. Ohmura is not relied upon to correct for at least the above noted deficiencies of Okino and Aoi. Therefore, independent claims 1 and 8 are also distinguishable over the combination of Okino, Aoi and Ohmura. Accordingly, claims 12-14, 21 and 25 are also distinguishable over the combination of Okino, Aoi, and Ohmura for at least due to their dependencies from claims 1 and 8.

Applicant respectfully requests that the rejection of claims 5, 7, 12-14, 21-23 and 25 based on Okino, Aoi and Ohmura be withdrawn.

§ 103 REJECTION – OKINO, AOI, MATSUO

Claim 29 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okino, Aoi, and in further view of Matsuo (U.S. Patent 6,526,293). Applicant respectfully traverses.

Claim 29 depends from independent claim 1 and it is demonstrated above that claim 1 is distinguishable over Okino and Aoi. Matsuo is not relied upon to correct for at least the above noted deficiencies of Okino and Aoi.

Therefore independent claim 1 is also distinguishable over the combination of Okino, Aoi and Matsuo. Accordingly, claim 29 is also distinguishable over Okino, Aoi and Matsuo for at least due to its dependency from claim 1.

Applicant respectfully requests that the rejection of claim 21 based on Okino, Aoi and Matsuo be withdrawn.

§ 103 REJECTION – OKINO, AOI, KAWAMURA

Claim 32 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Okino, Aoi, and in further view of Kawamura (U.S. Patent 5,784,105). Applicant respectfully traverses.

Claim 32 depends from independent claim 30 and it is demonstrated above that claim 30 is distinguishable over Okino and Aoi. Kawamura is not relied upon to correct for at least the above noted deficiencies of Okino and Aoi. Therefore independent claim 30 is also distinguishable over the combination of Okino, Aoi and Kawamura. Accordingly, claim 32 is also distinguishable over Okino, Aoi and Kawamura for at least due to its dependency from claim 30.

Applicant respectfully requests that the rejection of claim 21 based on Okino, Aoi and Kawamura be withdrawn.

NEW CLAIMS

In this reply, claims 37-44 are added. No new matter is presented. It is respectfully submitted that the new claims are distinguishable over the cited references, individually or in any combination, for at least due to their dependencies from independent claims. Applicant respectfully requests that the new claims be allowed.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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